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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/812,816	03/21/2001	Masahiko Honda	040405/0334	1908
22428	7590	08/24/2004	EXAMINER	
FOLEY AND LARDNER SUITE 500 3000 K STREET NW WASHINGTON, DC 20007			KIANERSI, MITRA	
			ART UNIT	PAPER NUMBER
			2143	

DATE MAILED: 08/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/812,816

Applicant(s)

HONDA, MASAHIKO

Examiner

mitra kianersi

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 2000-080708.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) *
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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Claims 1-18 have been examined.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Hasegawa (US 2002/0178137).

1. As per claim 1, an electronic mail transfer device, which receives an electronic mail sent from a sending terminal through a communication line and sends the received electronic mail to a receiving terminal through the communication line according to an address of a destination party attached to the electronic mail, comprising:

- a means for separating the electronic mail into text data and the other data when the received electronic mail includes the data other than the text data; (an electronic mail system including a communication line, and at least one transmitting terminal, at least one receiving terminal, and at least one communication terminal connected to each other through the communication line, the communication terminal receiving, through the communication line, an electronic mail sent by the transmitting terminal and transferring the received electronic mail to the receiving terminal corresponding to an address of the electronic mail. The transmitting terminal attaches song data comprising musical tone control information, to the electronic mail, and transmits the electronic mail with the song data attached, to the communication terminal, abstract),
- a means for sending only the text data to the separated text receiving terminal after relating the data with the data other than the text data. (stores the received electronic mail

in a storage device, notifies the receiving terminal of receipt of the electronic mail, and retrieves the electronic mail and the song data attached to the mail from the storage device, and transfers them to the receiving terminal, when the receiving terminal requests receipt of the electronic mail in response to notification by said notifying device. The receiving terminal opens the received electronic mail, and automatically reproduces the song data attached to the electronic mail. Abstract)

2. As per claims 2, 9 and 16, an electronic mail transfer device as set forth in Claim 1, further comprising:

a means As per claim 1s for storing the separated data other than the text data with a discriminating symbol attached there; and a means for inserting the discriminating symbol into the text data, the text data with the discriminating symbol inserted therein being sent by said sending means to the receiving terminal through the communication line. (This step is inherent, because the receiving terminal recognizes the notification of the receipt of the mail from the server computer 102 at a step S4, and sends a command to the server computer 102 to request the electronic mail data that has been stored in the storage device of the server computer 102, to be downloaded into the receiving terminal at a step S5, [0053] and, the receiving terminal accesses the server computer 102 to retrieve the received mail. The server computer 102 recognizes the request from the receiving terminal at a step S6, and downloads the electronic mail data under request, to the receiving terminal at a step S7. [0054])

3. As per claims 3, 10 and 17, an electronic mail transfer device as set forth in Claim 2, wherein the data other than the text data related with the text data and stored in said storing means is sent to the receiving terminal or deleted, at a request of the receiving terminal. (This step is inherent, because the receiving terminal recognizes the notification of the receipt of the mail from the server computer 102 at a step S4, and sends a command to the server computer 102 to request the electronic mail data that has been stored in the storage device of the server computer 102, to be downloaded into the receiving terminal at a step S5, [0053] and, the receiving terminal accesses the

server computer 102 to retrieve the received mail. The server computer 102 recognizes the request from the receiving terminal at a step S6, and downloads the electronic mail data under request, to the receiving terminal at a step S7. [0054])

4. As per claims 4, 11 and 18, an electronic mail transfer device as set forth in Claim 2, further comprising:
a means for assigning a temporary tag for the number of the separated data other than the text data, to the separated text data, said inserting means replacing the tag with the corresponding discriminating symbol. (This step is inherent, because the receiving terminal recognizes the notification of the receipt of the mail from the server computer 102 at a step S4, and sends a command to the server computer 102 to request the electronic mail data that has been stored in the storage device of the server computer 102, to be downloaded into the receiving terminal at a step S5, [0053] and, the receiving terminal accesses the server computer 102 to retrieve the received mail. The server computer 102 recognizes the request from the receiving terminal at a step S6, and downloads the electronic mail data under request, to the receiving terminal at a step S7. [0054])

5. As per claims 5 and 12, an electronic mail transfer device as set forth in Claim 1, wherein the communication line is the Internet. (Internet, and a telephone line, for example, to be connected to the server computer 102 or other client computer 103, through the communication network 101, [0046])

6. As per claims 6 and 13, an electronic mail transfer device as set forth in Claim 1, wherein the data other than the text data is an attached file. (the electronic mail data means data of an electronic mail to which song data or voice data is attached. [0051])

7. As per claims 7 and 14, an electronic mail transfer device as set forth in Claim 1, wherein the data other than the text data is graphic data or a Computer executable

program. (these functions of musical tone synthesization and sounding may be performed by software means (musical tone synthesis means and effect imparting means) which are realized by executing a program such as a musical tone generating program by the CPU. [0079])

8. As per claim 8, an electronic mail transfer system provided with an electronic mail transfer device of receiving an electronic mail sent from a sending terminal through a communication line and sending the received electronic mail to a receiving terminal through the communication line according to an address of a destination party attached to the electronic mails a sending terminals for sending electronic mail transfer device through the communication line, and a plurality of the receiving plurality of the electronic mail to the terminals for receiving the electronic mail sent from the electronic mail transfer device through the communication line, in which the electronic mail transfer device comprises: a means for separating the electronic mail into text data and the other data when the received electronic mail includes the data other than the text mail transfer system provided with data; and (an electronic mail system including a communication line, and at least one transmitting terminal, at least one receiving terminal, and at least one communication terminal connected to each other through the communication line, the communication terminal receiving, through the communication line, an electronic mail sent by the transmitting terminal and transferring the received electronic mail to the receiving terminal corresponding to an address of the electronic mail. The transmitting terminal attaches song data comprising musical tone control information, to the electronic mail, and transmits the electronic mail with the song data attached, to the communication terminal, abstract),
a means for sending only the text data to the receiving terminal after relating the separated text data with the data other than the text data. (stores the received electronic mail in a storage device, notifies the receiving terminal of receipt of the electronic mail, and retrieves the electronic mail and the song data attached to the mail from the storage device, and transfers them to the receiving terminal, when the receiving terminal requests receipt of the

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electronic mail in response to notification by said notifying device. The receiving terminal opens the received electronic mail, and automatically reproduces the song data attached to the electronic mail. Abstract)

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mitra Kianersi whose telephone number is (703) 305-4650. The examiner can normally be reached on 7:00AM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on (703) 308-5221. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mitra Kianersi
08/06/2004


DAVID WILEY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100